

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the amendments to the claims, the various attachments and the following remarks.

Claims Status

Claims 1 and 3-18 are presented for further prosecution.

Claim 1 has been amended to add the limitations of Claim 2 and Claim 2 has been canceled.

Because of the incorporation of Claim 2 into Claim 1, Claims 3-6 have, likewise, been amended.

Prior Art Rejections

Claims 1-18 had been rejected as being anticipated by Ohmura and as being unpatentable over a combination of Uchida, Hayashi and EP '062.

As noted by the Examiner, Ohmura is cited under 102(a) and is not a 102(b) reference. Likewise, EP '062, is not a 102(b) reference because it has a date of Publication of January 28, 2004, less than one year before the filing date of this Application.

Attached hereto, is a Declaration under Rule 1.131 which alleges a date of Invention of at least as early as August 8, 2001. Based on the 131 Declaration, Applicants have sworn behind both Ohmura and EP '062. Ohmura has a U.S. filing date of March 15, 2002 and EP '062 has a Publication date of January 28, 2004, both of which are later than Applicants' August 8, 2001 date of invention. Thus, it is respectfully submitted that Ohmura and EP '062 are no longer prior art.

With respect to the 131 Declaration, the evidence submitted to prove the date of invention is a copy of the corresponding Japanese Application which was filed in the Japanese Patent Office on August 8, 2001. An English Translation of the Japanese Application is provided and the Inventors attest to the fact that the examples and tests that are reported in the Japanese Application were, in fact, run and the results therein were obtained, i.e.

actual reduction to practice of the invention. Furthermore, the Inventors note that the text of the Japanese Application is substantially similar to the text in the present Invention.

Respectfully, Applicants have demonstrated that they actually reduced to practice the claimed Invention at least as early as August 8, 2001 and, thus, have sworn behind both Ohmura and EP '062.

In light of Rule 1.131 Declaration, it is submitted that the anticipation rejection based on Ohmura is now overcome.

With respect to the 103 rejection based on a combination of Uchida, Hayashi and EP '062, it is respectfully submitted that the elimination of EP '062 as prior art now overcomes the rejection based on a combination of Uchida, Hayashi and EP '062 because neither Hayashi or Uchida teach the element that was present in EP '062 and, thus, the 103 rejection is now overcome.

112 Rejection

Claims 1-18 have been rejected under 35 USC 112, second paragraph, as being too broad.

Applicants note that they have amended Claim 1 to recite the limitation of Claim 2. Applicants believe that the original Claim 1 was sufficient to comply with 35 USC 112, second paragraph, however, Applicants have amended Claim 1 to add the limitations of Claim 2. However, Applicants wish to point out that in accordance with MPEP 2173.04, the breadth of the claim is not to be equated with indefiniteness. Furthermore, regarding the composition definition, Applicants have amended Claim 1 to define that the crystalline compound comprises crystalline polyester. Crystalline polyester plays an important role in providing the toner with the claimed thermal behavior in DSC. It is respectfully submitted that the composition limitations of amended Claim 1 are sufficiently definite to meet the requirements of 35 USC 112, second paragraph.

Information Disclosure Statement

Attached hereto is a copy of an Office Action dated May 23, 2006 from the Japanese Patent Office in the corresponding Japanese case. Also enclosed is an English Translation of that Office Action.

Also enclosed is PTO Form SB/08A listing each one of the references cited in the Japanese Office Action along with copies of each of the cited references and English Abstracts thereof which has been attached to the front of the Japanese cases.

It is noted that this Information Disclosure Statement is being filed within three months from the date of the Office Action from the corresponding Japanese Application, thus, Applicants make the following statement:

"Each item of information contained in the Information Disclosure Statement was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement herein."

If, for any reason, any fees are necessary to consider this Information Disclosure Statement, authorization is given to ~~debit~~ Account #02-2275.

Request for Two Month Extension of Time

Applicants hereby request a two-month extension of time within which to file their Response to the outstanding Office Action. This extends the time for filing to August 9, 2006. Should any additional fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account #02-2275.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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Encl: Executed PTO 2038
Unexecuted Rule 1.131 Declaration
Copy of Published Japanese Appln.
No. 2001-240507 with English Translation
PTO Form SB/08A and references
Return receipt post-card